

REMARKS/ARGUMENTS

Claims 24, 29-34 and 39-48 are active. New Claim 44 tracks the limitations in Claim 24, except that it omits a collection step and is more broadly directed to detecting polymorphism at position 421. Claims 45-46 find support as for Claim 24. Claims 47-48 find support in paragraphs [0051-0052] are describe particular Taqman and Invader methods using expanded alternative language. The Applicants do not believe that any new matter has been introduced.

Restriction/Lack of Unity

The Applicants previously elected with traverse, Group I, Claims 1-4, 8 and 20-21. An election of the SNP (single nucleotide polymorphism) at position 421 of SEQ ID NO: 1 was also made. Claims 5-7, 9-19 and 22-23 have been withdrawn from consideration and the Restriction/Lack of Unity Requirement made FINAL.

Priority

A certification for the English translation of Japanese Application 2002-175806 previously filed on March 30, 2007 is attached herewith.

Objection—Claims

Claims 24-27 were objected to as referring to a nonelected invention. This objection is moot in view of the amendments above.

Rejection—35 U.S.C. §112, first paragraph

Claims 24-35 were rejected under 35 U.S.C. 112, first paragraph, as lacking adequate description. The Applicants thank the Examiner for referring to enabled subject matter. This rejection is moot in view of the amendments above.

With respect to Claim 44, given the disclosure that a polymorphism at position 421 affects a decreased capacity to excrete compound B, and the limited number of polymorphisms (2 other bases), it would have been well within the skill of the art to determine the effects of other polymorphisms at this position without undue experimentation. Moreover, this claim is limited to only those polymorphisms that decrease excretion of compound B. Claim 44 also omits a routine collection step since those with skill in the art would be capable of practicing the invention by collecting a sample themselves, obtaining a sample from others, or by obtaining sequence data from particular cell from other sources. Again, no undue experimentation would be required to practice the invention based on the high level of skill in the art and the routine nature of sample or data collection.

Rejection—35 U.S.C. §112, second paragraph

Claims 24-35 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. This rejection is moot in view of the amendments above or remarks below.

Claims 32-33 refer to the Taqman and invader methods which were well-known to those of skill in the art at the time of invention, see e.g., U.S. Patent No. 6,033,680 issued March 7, 2000 or U.S. Patent No. 5,994,069 issued November 30, 1999.

Compound B is disclosed on page 13, lines 1-2 of the specification by reference to WO95/30682.

Thus, the Applicants respectfully request that these grounds of rejection be withdrawn.

Rejection—35 U.S.C. §102(b)

Claims 25, 28-31 and 35 were rejected under 35 U.S.C. 102(a) as being anticipated by Imai et al., Mol. Canc. Ther. 1:611. This rejection is moot in view of the perfection of the priority claim.

Rejection—35 U.S.C. §103

Claims 25-27 were rejected under 35 U.S.C. 103(a) as being anticipated by Imai et al., Mol. Canc. Ther. 1:611, in view of Komatani et al., Canc. Res. This rejection is moot in view of the perfection of the priority claim.

Rejection—35 U.S.C. §103

Claim 32 was rejected under 35 U.S.C. 103(a) as being anticipated by Imai et al., Mol. Canc. Ther. 1:611, in view of Kwok et al., U.S. Patent No. 5,945,283. This rejection is moot in view of the perfection of the priority claim.

Rejection—35 U.S.C. §103

Claim 33 was rejected under 35 U.S.C. 103(a) as being anticipated by Imai et al., Mol. Canc. Ther. 1:611, in view of Brow et al., U.S. Patent No. 5,846,717. This rejection is moot in view of the perfection of the priority claim.

Conclusion

In view of the amendments and remarks above, the Applicants respectfully submit that this application is in a condition for allowance. Early notification of such is earnestly requested.

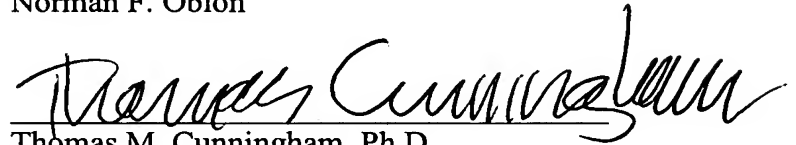
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Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Thomas M. Cunningham", written over a horizontal line.

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VERIFICATION OF A TRANSLATION



I, the below named translator, hereby declare that:

My name and post office address are as stated below ;

(1) that I am fluent in both the Japanese and English languages;

(2) that I translated the document identified as corresponding to Japanese Patent Application 2002-175806 filed in Japan on June 17, 2002, from Japanese to English;

(3) that the English translation filed on March 30, 2007 with the U.S. Patent and Trademarks Office, is a true and correct translation of Japanese Patent Application 2002-175806, to the best of my knowledge and belief; and

(4) that all statements made of my own knowledge are true and that all statements made on information and belief are believed to be true and further, that these statements are made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 USC 1001, and that such false statements may jeopardize the validity of the application or any patent issuing thereon.

Date

July 25, 2007

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